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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,106	12/17/2001	Kagemoto Tohyama	OHA-0002	7765

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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,106	Applicant(s) TOHYAMA, KAGEMOTO	
	Examiner Kambiz Abdi	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The prior office action is incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 6, 7, 8, and 9 are amended.
- Claims 1-9 are pending.

Response to Arguments

2. Applicant's arguments filed April 13, 2006 have been fully considered but they are not persuasive for the following reasons:

In response to applicant argument regarding rejection of Claims 1--9 under 35 U.S.C. § 102 as being anticipated by Stefik U.S. Patent Application Publication No. 2003/0167236 A1.

3. Contrary to applicant's assertion, Stefik clearly discusses the presence of the "Terminal", for example in paragraph [0093] it is clearly stated that " the usage transactions handler 1303 comprise **functionality** for processing access requests to digital works..." It is clear that there need to be an interaction between the requester and the server for obtaining a pass (ticket or token) to be used for controlling the execution (use) of the software (digital works). One can even look at the teachings of the Stefik and clearly observe that the pass (Ticket) can be used in conjunction with a terminal (ticket agent) that controls the usage of the software (digital work) according to the rights and approvals in the pass (usage rights and terms of use). Applicant's attention is drawn to the "Appendix A" of the Stefik patent application publication as it is clearly stated, "The authorization must be obtained before the right may be exercised." One skill in the art can clearly observe by Stefik teachings that terms and condition as well as number of copies or prints or rendering is clearly thought (See paragraphs [0018], [0048], [0072], [0086], [0088],[0110], [0166], [0168], and [0248]). It should be emphasized that the applicant in its remarks section refers to a particular section of Stefik paragraph [0046], however, the examiner has sited numerous passages of the prior art as relevant sections in particular and for the convenience of the applicant specific sections. In addition it should be noted that the **entire** reference should be considered and not just a few paragraphs out of context of the entire prior arts teachings.

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4. Therefore, the rejections of claims 1-9 are here maintained as below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "and performable creating and updating the license menu;" is not clearly understood and what the applicant is trying to achieve by this step, the step is vague and unclear.

7. Claim 1, 2, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 8 contain the phrases "for storing...", "capable of...", "then becomes able to...", "to be given...", which renders the claims as being indefinite as well as the phraseology used makes the claims to be construed as intended use. Also the claim 2 contains the phrase "capable of", which renders the claims as being indefinite as well as the phraseology used makes the claims to be construed as intended use.

8. Claims are directed towards and intended use, capabilities, and structure which will result upon the performance of future acts, as positive structural limitations; he seems to believe that his invention (on which a claim in proper structural form has been allowed) is particularly pointed out and distinctly claimed within the meaning of section 112 because of presence of these statements. He is apparently aware of the necessity for limiting his claim as he thinks he has done. We agree with the Board, however, that the claim does not positively recite structural relationships of the two elements, identified as [1] and [2], in its recitation of what may or may not occur. In this sense it fails to comply with section 112, second paragraph, in failing distinctly to claim what appellant in his brief insists is his actual invention. See *In Re John Covell Collier* [55 CCPA; 897 F.2d 1003; 158 USPQ 266].

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9. Claims 2-5 being dependent to reject claim 1 also are rejected based on the same rational as above.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0167236 A1 to Mark J. Stefik et al.

12. As per claim 1, Stefik clearly teaches a software licensing system comprising:

a licensing terminal for storing a license menu which includes information on a function, a term and a number of times that a usage is approvable for a software that is subject to usage approval (See Stefik abstract, figures 15 and 18 and associated text, paragraph [0015]-[0018], paragraph [0018], [0046], [0048], [0072], [0086], [0088],[0110], [0166], [0168], and [0248], and paragraph [0066] table 1); and

a user terminal capable of accessing the license menu via a communications line;

supplier terminals capable of accessing the license menu via communications line and performable creating and updating the license menu (See Stefik paragraphs [0282]-[0290], [0291]-[0292], [0308]-[0310], and [0317]-[0319]); wherein when the licensing terminal creates and sends to the user terminal a pass containing information on the function, the term and the number of times that the usage is approvable based on an agreement/selection by the user terminal, the user terminal then sends, to the software for which usage approval is to be given, a run-approval or a run-disapproval command data

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according to information on the function, the term and the number of times of the usage contained in the received pass, and the user terminal then becomes able to use the software according to the content of the usage approval in the pass created by the license terminal (See Stefik abstract, figures 15 and 18, paragraph [0015]-[0018], paragraph [0046], and paragraph [0066] table 1).

13. As per claim 2, Stefik clearly teaches a software licensing system according to claim 1, wherein the pass given to the user terminal contains a pass status data indicating the current validity of the function, the term and the number of times of the usage, and then in the case where the pass status data of the pass received from the user terminal is "Valid", the licensing terminal creates and sends to the user terminal a portable pass which contains information on the functions, the term and the number of times that the usage has been approved based on the agreement/selection by said user terminal and the pass status data indicating the current validity of this usage approval content, said portable pass being capable of being moving to another user terminal other than said user terminal; and at said other user terminal it is possible, based on the portable pass which has been moved from the first user terminal, to use the same software as the software that has already been used at the first user terminal (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0069], [0072], [0113], [0167], [0225], and [0475]).

14. As per claim 3, Stefik clearly teaches a software licensing system according to claim 2, wherein when the user terminal receives the portable pass, the user terminal changing the pass status data of the pass to "Currently Being Moved", and sends run-prohibition command data to the software which has already been usage-approved to thereby make the software unusable (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0078], [0113], [0167], [0225], and [0475]).

15. As per claim 4, Stefik clearly teaches a software licensing system according to claim 2 or claim 3,

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wherein in the case where the pass status data of the portable pass received from the other user terminal is "Currently Being Moved", the licensing terminal creates a new pass and sends the new pass to the other user terminal; and

the other user terminal sends, to said software, run command data in accordance with information on the function, the term and the number of times of use that was included in the new pass, to thereby make it possible for the other user terminal to use said software (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0113], [0167], [0168], [0225], and [0475]).

16. As per claim 5, Stefik clearly teaches a software licensing system according to claim 4, wherein when the other user terminal receives the new pass, the other user terminal changing the pass status data of said portable pass to "Invalid", to thereby invalidate the portable pass (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0113], [0167], [0225], and [0475]).

17. As per claim 6, Stefik clearly teaches a software licensing terminal comprising:
means for storing the license menu which includes the function, the term and the number of times that a usage is approvable for the software that is subject to usage approval;
means for creating a pass containing the function, the term and the number of times that the usage is approvable based on the agreement/selection by the user terminal that is connected via a communications line; and means for sending the pass to the user terminal via the communications line (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0092], [0113], [0167], [0170], [0225], and [0475]); and
means for accessing the license menu via communications line and performable creating and updating the license menu (See Stefik paragraphs [0282]-[0290], [0291]-[0292], [0308]-[0310], and [0317]-[0319])

18. As per claim 7, Stefik clearly teaches a computer program wherein, by means of a control means of a licensing terminal which can connect via a communications line to the user terminal that uses the

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software for which usage approval has been given and which stores a license menu containing the function, the term and the number of times that a usage is approvable for said software, said computer program executes the processing for:

(a) sending to the user terminal a license menu that pertains to said software (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1);

(b) receiving agreement/selection data that contains information on the function, the term and the number of times of use that the user terminal agreed/selected from the license menu, and creating a pass that contains information on the function, the usage period that the usage is approvable for said software, based on said agreement/selection data (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0113], [0167], [0220], [0264], [0482]); and

(c) sending the pass to the user terminal (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0113], [0167], [0220], [0264], [0482]); and

(d) accessing the license menu via communications line and performable creating and updating the license menu (See Stefik paragraphs [0282]-[0290], [0291]-[0292], [0308]-[0310], and [0317]-[0319])

19. As per claim 8, Stefik clearly teaches a user terminal comprising:

means for connecting, via a communications line, to a licensing terminal that stores a licensing menu which includes the function, the term and the number of times that a usage is approvable with respect to the software for which usage approved is to be given;

means for receiving from the licensing terminal a pass containing the function, the term and the number of times of use which were agreed/selected from the license menu; and

means for sending, to said software, run-approval or run-disapproval command data according to information on the function, the term and the number of times of use contained in the received pass (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0113], [0167], [0225], and [0475]); and

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means for accessing the license menu via communications line and performable creating and updating the license menu (See Stefik paragraphs [0282]-[0290], [0291]-[0292], [0308]-[0310], and [0317]-[0319])

20. As per claim 9, Stefik clearly teaches a computer program wherein, by means of a control means of a user terminal that can connect via a communications line to a licensing terminal which stores a license menu containing the function, the term and the number of times that a usage is approvable regarding said software to be usage-approved, said computer program executes the processing for:

- (a) creating the agreement/selection data that contains information on the function, the term and the number of times of use which were agreed/selected from the license menu (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1); and
- (b) receiving from the licensing terminal a pass which contains the function, the usage period that the usage is approvable for said software based on said agreement/selection data and sending, to said software, a run-approval or run-disapproval command data in accordance with information on the function, the term and the number of times of use contained in the received pass (See Stefik abstract, figures 15 and 18, paragraphs [0015]-[0018], [0046], [0066] table 1, [0113], [0167], [0220], [0264], [0482]); and

supplier terminals capable of accessing the license menu via communications line and performable creating and updating the license menu (See Stefik paragraphs [0282]-[0290], [0291]-[0292], [0308]-[0310], and [0317]-[0319]).

21. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed

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invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

22. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

<http://portal.uspto.gov/external/portal/pair>

24. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Primary Examiner

KAMBIZ ABDI
PRIMARY EXAMINER
May 5, 2006



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